



IN THE UNITED STATES PATENT OFFICE  
BEFORE THE BOARD OF APPEALS AND INTERFERENCES

IN RE APPLICATION OF: )  
 )  
KARYN ELAINE ANDERSON )  
 )  
SERIAL NO.: 10/021,620 )  
 )  
FILED: December 11, 2001 )  
 )  
TITLE: METHOD OF USING )  
PREPAID CASH CARD FOR )  
MAKING PURCHASES ON )  
THE WORLD WIDE WEB )  
 )  
EXAMINER: NICHOLAS D. ROSEN )  
 )

GROUP ART UNIT NO. 3625

LETTER

Mail Stop - Appeals  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, Virginia 22313-1450

Sir:

The appellant in the above-identified application is herewith submitting its appeal brief (including an Appendix A), along with the \$250.00 appeal brief filing fee.

Please charge any cost or credit any overpayment to deposit account 19-0258


Dated: January 31, 2006

Respectfully submitted,

ROBERT J. SCHAAP  
Registration No. 20,577  
Attorney for Applicant  
(818) 346-6555

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to: MAIL STOP, COMMISSIONER FOR PATENTS, P.O. BOX 1450, ALEXANDRIA, VIRGINIA 22313-1450 on 1-31-, 2006.

  
\_\_\_\_\_  
(Signature)      Date of Signature: 1-31, 2006

C:\Documents and Settings\All Users\Documents\Data\Anderson, Karyn\Appeal\Letter 1-31-06

2-206

AFS  
Zhu



IN THE UNITED STATES PATENT OFFICE  
BEFORE THE BOARD OF APPEALS AND INTERFERENCES

IN RE APPLICATION OF: )  
 )  
KARYN ELAINE ANDERSON )  
 )  
SERIAL NO.: 10/021,620 )  
 )  
FILED: December 11, 2001 )  
 )  
TITLE: METHOD OF USING )  
 )  
PREPAID CASH CARD FOR )  
 )  
MAKING PURCHASES ON )  
 )  
THE WORLD WIDE WEB )  
 )  
EXAMINER: NICHOLAS D. ROSEN )  
 )

GROUP ART UNIT NO. 3625

APPEAL BRIEF

Mail Stop - Appeals  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, Virginia 22313-1450

Sir:

I.

INTRODUCTION

This appeal is based on a Final Rejection advanced by the Examiner in the Office Action dated August 2, 2005, and in which the Examiner rejected all of the claims in the application, namely Claims 1, 3-8, 13-16, 18-24, 26, and 27, under 35 USC 103(a). The Examiner relied upon certain prior art references along with a

TABLE OF CONTENTS

	<u>PAGE</u>
I. INTRODUCTION.....	1
II. REAL PARTY IN INTEREST.....	2
III. RELATED APPEALS AND INTERFERENCES.....	2
IV. STATUS OF THE CLAIMS.....	2
V. STATUS OF AMENDMENTS.....	4
VI. SUMMARY OF THE CLAIMED SUBJECT MATTER.....	4
a) Essence of the Invention.....	4
b) Essence of the Claims.....	6
VII. GROUNDS FOR REJECTION FOR REVIEW ON APPEAL.....	6
VIII. ARGUMENTS ON APPEAL.....	7
1. Prior Art Applied Against Claims .....	7
A. Cited Prior Art References.....	7
B. The Examiner Relies Upon Prior Art in which There are Numerous Missing Limitations.....	11
C. The Examiner has Combined References Without Any Basis for Combination.....	15
D. The Examiner Has Completely Overlooked or Dismissed One of the Critical Limitations in the Claims.....	19
E. The Examiner's Rejection isBased Entirely on Hindsight .....,.....	22
F. Standard of Review.....	24
APPENDIX A (Claims) .....	A-1

reliance upon Official Notice allegedly teaching of certain limitations set forth in the claims.

II.

REAL PARTY IN INTEREST

The real party in interest in this application and in the subject matter of this application is the inventor, namely Karyn E. Anderson.

III.

RELATED APPEALS AND INTERFERENCES

There are no related appeals or interferences, formerly or now pending, by this applicant containing subject matter related to this application on appeal.

IV.

STATUS OF THE CLAIMS

- 1) Claims 1, 3-8, 13-16, 18-24, 26 and 27 are pending in the application and all stand finally rejected.
- 2) There are no allowed claims in the application.
- 3) All of the claims in the application remain under final rejection on the grounds that certain of, and in some cases all, of the limitations are well known. In taking of Official Notice of certain limitations for support

thereof, the Examiner relies upon the Murveit et al. U.S. patent No. 6,570,964 and the Ladd patent No. 6,097,791, the Wyard et al. patent No. 6,167,398, the Teare et al. patent No. 6,151,624, the Walker patent No. 6,163,771, and the Reiter patent No. 6,178,411. The Examiner also took alleged Official Notice and argued in support thereof the anonymous "New Fujitsu Teampad 500 Adds Color", and the anonymous "Debit Cards Hold Advantages for Supermarkets" and the article "Solutran Offers E-Commerce Payment Alternative", the Gage article, "Retail POS Debits Finally Take Off", and the anonymous article "Credit Cards Can Buy Groceries". The Examiner further relies upon Official Notice supported by the Hills et al. U.S. patent No. 6,164,528, and the Boesch et al. U.S. patent No. 6,205,433.

- 4) The claims were also rejected on the basis of the Bielski article "New Wave of E-Money Options Hits the Web", in view of the anonymous article "RealStores.com Now Accepting Internet Cash for E-Commerce Transaction" (hereinafter ("RealStores")).
- 5) Certain of the claims were rejected under 35 USC 103(a) as being unpatentable over Bielski in view of the anonymous article "RealStores.com". The Examiner also further relies upon the "Redman" article.

V.

STATUS OF AMENDMENTS

An Amendment was filed in the U.S. Patent Office in response to the first Official Office Action of February 2, 2005. In response to that Amendment, the Examiner issued the Office Action dated August 2, 2005, constituting a Final Rejection. No Amendments were submitted after that Office Action of August 2 2005.

VI.

SUMMARY OF CLAIMED SUBJECT MATTER

a) Essence of the Invention:

The invention primarily relates to a method for making an on-line purchase of a selected product or service. More specifically, the method comprises the purchasing of a card carrying a unique identification code for the user. Conventional credit cards and conventional debit cards, for that matter, carry a specific identification code of a user. However, the drawback is that these credit cards contain other identification information of a user, which allows a thief of that credit card or debit card, to access information about the user and become an identity thief.

The card system of the present invention is a wide departure from the conventional credit card and the conventional debit card. The card given to the user in the present invention carries only

the unique identification code and no other information on its face, which could be used to identify the user.

When a user selects a product or a service to purchase, he or she can allow the seller to transmit the identification code of that card for verification. If the issuer of the card verifies to a merchant the validity of the account, the user can identify whether the amount of the purchase is approved or not approved. If there is a sufficient cash balance in the account, an approval code is sent to the seller. At this point, the purchase price of this selected product or service is then debited from the cash balance of the holder's account. In like manner, if the identification code is determined to be invalid, or there is an insufficient cash balance to complete the intended purchase, a denial code is sent to the seller.

It may well be appreciated that in this day and age, identity theft has become a serious problem. Identity theft can occur, and frequently does occur, with nothing more than a user's conventional credit card or debit card. The card of the present invention precludes the improper user from seeking sensitive information. Hence, there is little or no risk in use of the card of the present invention for making an internet acquisition.



b) Essence of the Claims:

VII.

GROUND OF REJECTION TO BE REVIEWED ON APPEAL

- 1) Whether Claims 1, 3-8 and 13-15 patentably distinguish over Bielski ("New Wave of E-money Options Hits the Web"), in view of the anonymous article "RealStores.Com Now Accepting Internet Cash for E-commerce Transactions" (hereinafter "RealStores.Com"), and the anonymous article "Internet's First Pre-paid Shopping Card Launched" (hereinafter "Internet's First" and Official Notice taken by the Examiner, and also in further combination with "RealStores.Com", "Internet's First", and "Official Notice", and "Redmond" (Interface Enables Phone Downloads)).
- 2) Whether Claims 16 and 18-23 patentably distinguish over Bielski, in view of the anonymous article "RealStores.Com" and the anonymous article "Internet's First Pre-paid Shopping Card Launched" (hereinafter "Internet's First"), as well as Official Notice.
- 3) Whether the Official Notice taken by the Examiner, on numerous occasions, is properly justified.
- 4) Whether Claims 24, 26 and 27 are patentable over Bielski, in view of the anonymous article "RealStores.Com" and the

anonymous article "Internet's First", and in further combination with "Redman".

- 5) Whether hindsight was used by the Examiner in reaching the conclusions of non-patentability.

VIII.

ARGUMENTS ON APPEAL

1. Prior Art Applied Against Claims.

A. Cited Prior Art References.

The references cited relied upon the Examiner in the final rejection include:

A-1) References Applied Against the Claims:

- 1) Bielski (New Wave of E-money Options Hits the Web).
- 2) Internet's First Pre-paid Shopping Card Launched; "Cybermoola Delivers Teen Online Sales to E-merchants".
- 3) "RealStores.Com Now Accepting InternetCash for E-commerce Transactions".

A-2) References Cited in Support of Official Notice:

- 1) Murveit et al U.S. Patent No. 6,570,964 (Abstract: column 1, line 66, through column 3, line 62).
- 2) Ladd U.S. Patent No. 6,097,791 (column 2, lines 37-55).

- 3) Murveit U.S. Patent No. 6,570,964 (Abstract: column 1, line 66, through column 3, line 62).
- 4) Wyard et al. U.S. Patent No. 6,167,398 (column 6, lines 22-31).
- 5) Teare et al. U.S. Patent No. 6,151,624 (column 11, lines 66, through column 12, line 11; column 13, lines 36-45).
- 6) Walker et al. U.S. Patent No. 6,163,771 (column 12, lines 20-39).
- 7) Reiter U.S. Patent No. 6,178,411 (column 19, line 14-35).
- 8) Anonymous article "New Fugitsu TeamPad 500 Adds Color" (especially paragraph beginning "In Japan...technology").
- 9) Anonymous article "Debit Cards Hold Advantages for Supermarkets" (especially two paragraphs beginning from "A merchant that chooses").
- 10) "Salutran Offers E-commerce Payment Alternative" (entire article).
- 11) "Gage Retail POS Debits Finally Take Off" (especially paragraph "Treasury managers see").
- 12) Anonymous article "Credit Cards Can Buy Groceries" (especially paragraph beginning "As with any retail electronic payment").

13) Hills et al. U.S. Patent No. 6,164,528 (Abstract:  
column 11, line 63, through column 12, line 5).

14) Bosh et al. U.S. Patent No. 6,205,433 (column 10,  
lines 27-50).

(A-3) Bielski (New Wave of E-money Options Hits the Web):

This is the primary reference relied upon by the Examiner. The system proposed operates on the basis of pay first, and then use, or acquire, the product. The amount of cash paid by the purchaser is stored on a particular server of internet cash. The cards offered are sold in certain denominations, and a limited number of retail convenience stores and gas stations are members. The customers activate the card at the internetcash ONE WORD site and use an alphanumeric code containing card covered by scratch-off ink. The user can make purchases at a member store, and when the customer pays for the purchases, he may use the internet cash card as a payment option.

A virtual window hosted by InternetCash is made available asking the purchaser to select a card number from a drop-down list. InternetCash although showing a type of debit card, is far from the teachings of the instant application, in which there is a completely secure transaction, with the only information passing being that of the card identification code and without any personal identifying information. Bielski admittedly has a card with a unique identification code and a predetermined cash balance. The

account is activated by providing the identification code without personal identification information. Beyond this, Beilski is silent about the teachings of the present invention.

(A-4)      Internet's First Pre-paid Shopping Card Launched;  
"Cybermoola Delivers Teen Online Sales to E-  
merchants":

This reference allows purchasers (exemplary thereof being teens), to activate a type of debit card in which they receive an account having a PIN number (account number). They are then available for visiting and making purchases directly at member e-merchant sites which accept this particular debit card. When paying, the teens only provide their account number, as well as a PIN number. A query is delivered from the merchant site to a cybermoola server for verification of the availability of funds. There is no teaching of the transmission of an acceptance code or a denial code.

The applicant has not discussed in detail each of the citations for alleged Official Notice, reserving the comments, where applicable, to be set forth later in the arguments. However, it goes without saying that the Examiner has had to rely upon such a large number of Official Notice takings that this, alone, would question the validity of the rejections.

(A-5)      "RealStores.Com Now Accepting InternetCash for E-commerce Transactions":

A technique for purchasing on-line through retail stores in which there is proposed a private credit card alternative to on-line shopping. The technique resides in a pre-paid store purchased card, which is available in various denominations. The article states that no personal consumer information is required, and no account information is maintained when the card is used. While this may be effective for a particular store, or a small group of stores, it is very limited, as the Examiner notes. However, there is no teaching of the store checking for validity of the card through the account number, and no return transmission of an approval code or a denial code.

B.      The Examiner Relies Upon Prior Art in which There are Numerous Missing Limitations.

This application represents a simple, but highly suspicious pattern of someone who has reviewed an application, has arrived at a conclusion about patentability, and then looks around for support to the conclusion. While the applicant would not even begin to suggest that the Examiner in this case is engaging in any unlawful or inequitable conduct, reviewers of fact situations, in many cases, reach a conclusion which seems logical on its face, but yet is without support.

It is noteworthy that even the Examiner has recognized numerous limitations which are not present in Bielski, the primary reference upon which the Examiner relies. There are numerous deficiencies in Bielski, alone, admitted by the Examining Attorney as follows:

- i) First of all, the Examiner notes that Bielski is not explicit about selecting one or more goods or services offered through a web site. Page 5 of the Office Action of August 2, 2005, lines 1-5.
- ii) The Examiner notes that Bielski does not disclose providing the identification code to the seller. Page 5, lines 5-8.
- iii) The Examiner admits Bielski does not explicitly disclose debiting the purchase price of the selected good or service. Page 5, lines 14-17.
- iv) The Examiner admits Bielski does not disclose verification by a card service. Page 5, lines 18-21.
- v) The Examiner notes that Bielski does not expressly disclose transmitting an approval code to the seller, if there is a valid code and a sufficient cash balance.

- vi) The Examiner inherently admits Bielski does not disclose transmitting a denial code if there is an in valid account or insufficient funds.
- vii) The Examiner also notes that Bielski does not disclose the activating step by calling the card service system (page 7, lines 11-14).
- viii) The Examiner notes that Bielski does not disclose that the activating step includes entering an identification code into a designated field of a card service system. Page 8, lines 1-4.
- ix) The Examiner admits Bielski does not disclose the step of crediting the seller with the value of the purchase price of the selected goods.
- x) The Examiner admits Bielski discloses using scratch-off ink rather than a peel-away strip. Page 8, lines 20-page 9, line 21.
- xi) Continuing further, the Examiner notes that Bielski does not disclose the card holder determining current account balance by contacting the card service system (page 9, lines 7-12).

With regard to the secondary references, such as Internet First:

- i) The Examiner admits that Internet First does not disclose determining whether the identification code is associated



with a valid and active account. Page 5, line 21-page 2, line 3.

ii) The Examiner admits that Internet First does not disclose searching a data base of activated accounts, page 6, lines 9-12.

iii) The Examiner notes that Internet First expressly does not disclose transmitting an approval code to the seller, if there is a valid code and a sufficient cash balance.

The above are only a limited list of the number of omissions in the primary reference and in one of the secondary references upon which the Examiner relies. Even though the Examiner may not use the language of the claims about what Bielski does not disclose, the fact remains that the Examiner has admitted at least eleven missing elements in one of the references alone.

The Examiner bears the initial burden, on review of the prior art or on any other ground, of presenting a prima facie case of unpatentability. In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). Applicant asserts that the Examiner has just not met this initial burden. Applicant also asserts that the limitations set forth in the claim have not been given proper weight, if at all. Instead of giving the claim limitations proper effect, the Examiner has erroneously inferred that certain limitations are taught in the prior art, in order to arrive at its rejection.

The appellant readily admits that there is no prohibition to combining references in support of a rejection under 35 USC 103. However, one must seriously question the propriety of any rejection which has to rely upon no less than two prior art references and fourteen takings of Official Notice as to Claim 1. Indeed, one must very seriously question the propriety of such rejections when there are no less than six teachings which are missing from a single claim, namely from Claim 1.

C. The Examiner Has Combined References Without Any Basis for Combination.

It also appears that the Examiner is picking and choosing elements of a claim almost with total disregard as to the environment in which the elements are used and then attempting to find those individual elements in the prior art, even if they are unrelated to the present invention. The Examiner has essentially chosen limitations of the references in view of the claims of this present application in an impermissible attempt to reconstruct the applicant's invention.

It is paramount that the applicant is actually the first to provide a card with a limited amount of cash value and in which the only identification is the code used on this card. It is simple, quick, and easy to use. More importantly, it does not suffer the

frailty of modern debit cards and credit cards, in which other information is identified. Consequently, even if the card of this invention should be lost, or if someone with untoward interests locates the card or information on the card, that party will be able to do nothing with the information on the card of the invention.

In Ecolochen, Inc. v. Southern California Edison, the CAFC again stated the law that:

"We have previously held that  
[t]he suggestion to combine may be found in  
explicit or implicit teachings within the  
references themselves, from the ordinary  
knowledge of those skilled in the art, or from  
the nature of the problem to be solved."  
WMS Gaming, Inc. v. International Game Tech.,  
184 F.3d 1339, 1355, 51 USPQ2d 1385, 1397  
(Fed. Cir. 1999).

"However, there still must be evidence that  
"a skilled artisan, confronted with the same  
problems as the inventor and with no knowledge  
of the claimed invention, would select the  
elements from the cited prior art references

for combination in the manner claimed."  
In re Rouffet, 149 F.3d at 1357, 47 USPQ2d at  
1456; see also In re Werner Kotzab, 217 F.3d  
1365, 1371, 55 USPQ2d 1313, 1317 (Fed. Cir.  
2000) ("[A] rejection cannot be predicated on  
the mere identification ...of individual  
components of claimed limitations. Rather,  
particular findings must be made as to the  
reason the skilled artisan, with no knowledge  
of the claimed invention, would have selected  
these components for combination in the manner  
claimed.").

It has also been established that a rejection cannot be based  
on the mere identification of individual components, but rather,  
findings must be made as to the reason why the skilled artisan,  
with no knowledge of the invention being claimed, selected these  
components for combination. Moreover, he must have selected these  
components in essentially the same manner, as claimed. Bielski and  
Internet's First cannot be combined in the manner as suggested by  
the Examiner, since the Internet First reference teaches away from  
the present invention. See Rohm and Haas Company v. Owens-Corning  
Fiberglass Corporation 196 USPQ 726 (1977 D.C. Ala.):

"The fact that, while all materials for accomplishing the invention were available to those skilled in the art, they did not avail themselves thereof, evidences invention." United States v. Adams, 383 U.S. 39, 51-52, 148 USPQ 478, 483-484 (1966); Copease Mfg. Co. v. Cormac Photocopy Corp., 242 F.Supp. 993, 1008, 146 USPQ 109, 121-122 (S.D. N.Y. 1965); Gilbert Spruance Co. v. Ellis-Foster Co., 114 F.2d 771, 773, 46 USPQ 535, 536-537 (3d Cir. 1940).

Internet First clearly teaches that teens activate their Cybermoola card and upon such activation receive both an account number and a pin number. In fact, the purchaser of any product or service must provide a card bearing the account number and the pin number, or otherwise must at least verbally provide this information before the card can be used. The article clearly states "When paying with Cybermoola Teens Provide Their Account and Pin Number". These two pieces of information are far more effective in enabling an identity thief, than with the single piece of information provided in applicant's card. Consequently, if anything, Internet First teaches away from the present invention.

There is another critical and non-obvious limitation in each of the claims now on appeal. In the applicant's invention, the applicant can make a purchase on-line or via the telephone merely by providing the identification code. The identification code could be introduced electronically, or even by voice or by copy of the credit card. Not one of the references relied upon by the Examiner, namely Bielski, RealStores.com and Internet First, describe the activating of the cards at a website. Moreover, and equally importantly is the fact that none describe the activation by telephone. In each case, it is absolutely necessary for the purchaser to appear at a cashier's stand or desk in order to enable the cashier to complete that purchase, along with the presence of the card. This concept is completely missing in the prior art.

D. The Examiner Has Completely Overlooked or Dismissed One or More of the Critical Limitations in the Claims.

It is paramount that each and every claim in this application call for activating an account only with the identification code and not with any personally identifying information. It is also paramount that the claims call for the fact that verification occurs only on the basis of the searching of accounts using only the identification code on the card.

It is the law that the Examiner must consider each and every limitation in a claim. The Examiner cannot dismiss that limitation or conveniently overlook the limitation merely because there are other limitations used in combination with the missing limitation. Specifically, and in the prior art, one can activate an account or have the account searched for validity and the minimum cash balance by using an account number and then along with other personally identifying information.

Cases starting with In Re Royka, 180 USPQ 580 (CCPA 1974) have held that all words in a claim must be considered in judging the patentability of that claim. Please also see In Re Wilson 165 USPQ 494, 496 (CCPA 1970). The Examiner cannot conveniently either overlook or merely sidestep limitations such as "only" and particularly when this type of a limitation is an important and critical limitation in the claim, distinguishing the claim from the prior art.

"All words in a claim must be considered  
in judging the patentability of that claim  
against the prior art." In re Wilson, 424  
F.2d 1382, 1385 (CCPA 1970).

Each of the claims in this application are clearly limited to the fact that only the account number appearing on the card is all

that is required for activation and all that is required for searching, and all that is required for authorizing a purchase or denying a purchase. No other information is required. As stated, the claims call for "only" the identification code and not any other personally identifying information. In Bielsky, other personally identifying information is required. Customers must activate using a 20-digit code on the back of the card, as well as an additional PIN number. RealStores.com does not teach of the invention. All that RealStores.com identifies is that the consumer can activate their card on line (nothing more). However, RealStores is really limited to activating their card at a website. And nowhere within the four corners of RealStores is there any suggestion that the card can be activated by telephone or personally. Internet's First also requires an account number and a PIN number. Accordingly, the references overlook important and critical limitations in the claims.

Neither the combination of Bielski nor Internet First teach of the transmitting of an approval code or a denial code based on the validity of the account and the amount of money still valid in that account. Hence, the Examiner is relying upon references which do not have any basis of combination. It is well established in the law that a:



"rejection cannot be predicated on the mere identification of individual components... rather, particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination...". Ruiz v. A.B. Chance Co., 234 F.3d 654 (Fed. Cir. 2000), 57 USPQ2d 1161, 1166. See also, Ecolochem, Inc. v. Southern California Edison, 56 USPQ2d 1065, and also quoting In Re Rouffet, 149 Fed.3d 1350, 1357, (Fed. Cir. 1998), 47 USPQ2d 1453, 1456.

E. The Examiner's Rejection is Based Entirely on Hindsight.

The courts have been cautious in not allowing an examiner to fall into the hindsight trap. Even with all of the omissions in the combination of references noted by the Examiner, he still maintains that there can be a basis for a rejection. The appellant urges that any such rejection necessarily must be based on the actual teaching of the invention by the appellant and the alleged combination of individual pieces and components. It is urged that where the Examiner has had to combine so many references to show the missing limitations, and attempts to reject the application on

the basis of that which is taught by the appellant, the entire rejection necessarily must be based on hindsight. Please see, for example, Uniroyal, Inc. v. Rudkin-Wiley Corp. 5 USPQ 2<sup>nd</sup> 1434, 1438 (Fed. Cir. 1988). This case, as well as progeny of this case, has held that it is not proper to use the claims and the prior art to recreate a facsimile of the claimed invention.

The Examiner has done nothing more than really reach conclusions based on his own understanding of what the prior art may teach without evidentiary support. The best that can be said is that each and every independent claim has no less than eleven missing limitations, and the Examiner has had to rely upon no less than eleven individual sources to support this basis of rejection. It almost defies imagination to believe that all such sources suggest a combination to lead to the invention of the applicant.

In the same Rohm and Haas case, supra:

"The courts have long recognized that many of the most important inventions appear simple and self-evident after they have been explained. But hindsight is recognized to be misleading and should not be relied upon to invalidate a patent," Diamond Rubber Co. v. Consolidated Tire, 220 U.S. 428, 435 (1911);

Arnold Pipe Rentals Co. v. Engineering Enterprises, Inc., 350 F.2d 885, 890, 146 USPQ 415-416, 419-420 (5<sup>th</sup> Cir. 1965); Duo-Flex Corp. v. Building Service Co., supra, at pages 96-97, 138 USPQ 543-545.

F. Standard of Review.

This reviewing Board is required to review the Examiner's basis of rejection to determine if the claims have been correctly construed as to the scope and meaning of each contested limitation. See Gechter v. Davidson, 116 F.3D 1454, 1457, 43 USPQ2d 1030, 1032 (Fed. Cir. 1997). Every limitation positively recited in a claim must be given effect in order to determine what subject matter that claim defines. In Re Wilder, 429 F.2d 447, 450, 166 USPQ 545, 548 (CCPA 1970).

When the Board reviews the Examiner's rejection, it must almost inevitably come to the conclusion that there are so many missing limitations which are not suggested for combination that the claims in this application are patentable. As pointed out previously, the Examiner has not considered each and every limitation, and more importantly, even if the Examiner had considered each and every limitation, which is not the case, there

Karyn Elaine Anderson  
Serial No. 10/021,620

was absolutely no basis to combine the references in the manner as suggested.

Thus, the applicant respectfully prays for an overturning of the Decision of the Examiner and allowance of each and every claim in the application.

Dated: January 31, 2006

Respectfully submitted,




ROBERT J. SCHAAP  
Registration No. 20,577  
Attorney for Applicant  
(818) 346-6555

Karyn Elaine Anderson  
Serial No. 10/021,620

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to: MAIL STOP, COMMISSIONER FOR PATENTS, P.O. BOX 1450, ALEXANDRIA, VIRGINIA 22313-1450 on 1-61, 2006.

 Date of Signature: 1-31, 2006  
(Signature)

C:\Documents and Settings\All Users\Documents\Data\Anderson, Karyn\Appeal\Appeal Brief 1-30-06



Karyn Elaine Anderson  
Serial No. 10/021,620

APPENDIX A

(Claims)

A copy of the claims pursuant to 37 CFR 1.192(c)(9) is included in the Appendix.

Appended hereto are copies of Claims 1, 3-8, 13-16, 18-24, 26, and 27 on appeal.

1. A method for making purchase transactions over the world wide web, comprising the steps of:

purchasing a card having a unique identification code and a predetermined cash balance;

activating an account associated with the card by providing only the identification code and not any personally identifying information to a card service system;

selecting one or more goods or services offered by a seller through a web-site;

providing the identification code of the card to the seller who then transmits the identification code to the card service system for verification, wherein the verification by the card service system includes the steps of determining if the identification code is associated with a valid and active account by searching a database of activated accounts, and if there is sufficient cash balance in the account to purchase the selected goods or services;

transmitting an approval code to the seller if the identification code is valid and a sufficient cash balance is available in the associated account to purchase the selected goods or services, or transmitting a denial code to the seller if the identification code is determined invalid or there is insufficient cash balance in the associated account to purchase the selected goods or services; and

debiting the purchase price of the selected goods or services from the cash balance of the account when an approval code is transmitted.

2. (Cancelled)

3. The method of claim 1, including the step of removing an obstruction covering the identification code after purchasing the card.

4. The method of claim 3, including the step of removing a peel-away strip covering the identification code.

5. The method of claim 1, wherein the activating step includes calling the card service system by telephone and providing the identification code.

6. The method of claim 5, wherein the activating step includes inputting the identification code via keystrokes of a keypad of the telephone when prompted by an automated system.

7. The method of claim 5, wherein the activating step includes an automated system having voice recognition software and the identification code is provided by voice.

8. The method of claim 1, wherein the activating step includes entering the identification code into a designated field of a card service system web-site.

9.-12. (Cancelled)

13. The method of claim 1, including the step of crediting the seller with the value of the purchase price of the selected



goods or services when debiting the cash balance of the card account.

14. The method of claim 1, including the step of a cardholder determining current card account cash balance by contacting the card service system.

15. The method of claim 14, including the step of transferring a minimal cash balance from one card account of a cardholder to another card account of the cardholder by contacting the card service system.

16. A method for making purchase transactions over the world wide web, comprising the steps of:

purchasing a card having a unique identification code and a predetermined cash balance;

removing an obstruction covering the identification code after purchasing the card;

activating an account associated with the card by calling the card service system by telephone and providing only the identification code and not any personally identifying information;

selecting one or more goods or services offered by a seller through a web-site;

providing the identification code of the card to the seller by entering the identification code into a designated field of the web-site, who then transmits the identification code to the card service system for verification;'

determining if the identification code is associated with a valid and active account and if there is a sufficient cash balance in the account to purchase the selected goods or services; and

transmitting an approval code to the seller if the identification code is valid and a sufficient cash balance is available, and crediting the seller with the value of the purchase price of the selected goods or services and debiting the purchase price of the selected goods or services from the cash balance of the account, or transmitting a denial code if the identification code is invalid or there is insufficient cash balance in the associated account to purchase the selected goods or services.

17. (Cancelled)

18. The method of claim 16, including the step of removing a peel-away strip covering the identification code.

19. The method of claim 16, wherein the activating step includes inputting the identification code via keystrokes of a keypad of the telephone when prompted by an automated system.

20. The method of claim 16, wherein the activating step includes an automated system having voice recognition software and the identification code is provided by voice.

21. The method of claim 16, wherein the determining step includes searching a database of activated accounts.

22. The method of claim 16, including the step of a cardholder determining current card account cash balance by

contacting the card service system.

23. The method of claim 22, including the step of transferring a minimal cash balance from one card account of a cardholder to another card account of the cardholder by contacting the card service system.

24. A method for making purchase transactions over the world wide web, comprising the steps of:

Purchasing a card having a unique identification code and a predetermined cash balance;

removing an obstruction covering the identification code after purchasing the card;

activating an account associated with the card by entering only the identification code into a designated field of a card service system web-site without any personally identifying information;

selecting one or more goods or services offered by a seller through a web-site;

providing the identification code of the card to the seller by entering the identification code into a designated field of the seller's web-site, who then transmits the identification code to the card service system for verification;

determining if the identification code is associated with a valid and active account and if there is a sufficient cash balance in the account to purchase the selected goods or services;

transmitting an approval code to the seller if the identification code is valid and a sufficient cash balance is available, and crediting the seller the value of the value of the purchase price of the selected goods or services and debiting the purchase price of the selected goods or services from the cash balance of the account, or transmitting a denial code if the identification code is invalid or there is insufficient cash balance in the associated account to purchase the selected goods or services;

a cardholder determining current card account cash balance by contacting the card service system; and

transferring a minimal cash balance from one card account of the cardholder to another card account of the cardholder by contacting the card service system.

25. (cancelled)

26. The method of claim 24, including the step of removing a peel-away strip covering the identification code.

27. The method of claim 24, wherein the determining step includes searching a database of activated accounts.

28.-29. (cancelled).